UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,633	01/10/2002	Akio Kobayashi	111632	6574
25944 OLIFF & BERI	7590 02/26/200 RIDGE, PLC	EXAMINER		
P.O. BOX 3208	350	SHAY, DAVID M		
ALEXANDRIA, VA 22320-4850			ART UNIT	PAPER NUMBER
			3735	
			MAIL DATE	DELIVERY MODE
			02/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)			
	10/041,633	KOBAYASHI ET AL.			
Office Action Summary	Examiner	Art Unit			
	david shay	3735			
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address			
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be time will apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).			
Status					
1) Responsive to communication(s) filed on <i>Nove</i> .	mber 26, 2007.				
	action is non-final.				
<i>,</i> —	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is				
closed in accordance with the practice under E					
Disposition of Claims					
4)⊠ Claim(s) <u>1,2,5-10,13 and 14</u> is/are pending in the application.					
4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.					
6)⊠ Claim(s) <u>1,2,5-10,13 and 14</u> is/are rejected.					
7) Claim(s) is/are objected to.					
8) Claim(s) are subject to restriction and/or	election requirement.				
Application Papers					
9)☐ The specification is objected to by the Examine	•				
10) ☐ The drawing(s) filed on is/are: a) ☐ acce		Examiner.			
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).					
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.					
Priority under 35 U.S.C. § 119					
<u> </u>	priority under 35 LLS C & 110(a)	(d) or (f)			
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:					
·—					
1. Certified copies of the priority documents have been received.					
2. Certified copies of the priority documents have been received in Application No3. Copies of the certified copies of the priority documents have been received in this National Stage					
application from the International Bureau (PCT Rule 17.2(a)).					
* See the attached detailed Office action for a list of the certified copies not received.					
See the attached detailed Office action for a list of the certified copies not received.					
Attachment(s)	,, — , , , , ,	(770, 440)			
Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) ∐ Interview Summary Paper No(s)/Mail Da				
3) Information Disclosure Statement(s) (PTO/SB/08) 5) Notice of Informal Patent Application					
Paper No(s)/Mail Date 6) Other:					

Applicant has submitted new drawings. These drawings are accepted.

With regard to the art rejection, applicant argues that Kubota does not disclosed the claimed energy densities, because Kubota discusses the use of 2.54 j/cm², referring to the examiner's attribution thereto of the teaching of 50 to 250 mJ/cm² as a "misinterpretation". The examiner must, respectfully disagree. The Kubota reference uses 213 nm radiation, and gives the 2.54 j/cm² in the context of using that radiation, Kubota goes on to note that this energy density-wavelength combination provides the same speed of tissue removal as the energy density-wavelength combination of 50 to 250 mJ/cm² at 193 nm. Thus it is clear that these two sets of parameters are equivalent for the purposes of operating on cell walls.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 5-10, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abela et al ('982) in combination with Matsuura et al (1998), Kubota et al, and Lewis et al. Abela et al ('982) teach the method as claimed except for the specific recitation of the use of a hollow fiber, the specific laser energies, or the quartz chip (please note that the absence of the quartz chip implies the absence of other structures predicated thereon, such as the hydroxide groups). Matsuura et al (1998) teaches forming hollow waveguides for the delivery of excimer laser light from hollow fibers that are coated with aluminum and are filled with an inert gas. Lewis et al teaches the desirability of using a wave guiding device with a tapered tip in a medical system and method for applying high energy radiation. Kubota et al teach that producing holes in cell walls can be done using energy densities between 50 and 250 mJ/cm² with 193 nm light (see column 5, line 17-23). Lewis et al teach the desirability of providing a tapered structure on

Application/Control Number: 10/041,633

Page 3

Art Unit: 3735

the distal end of a hollow optical fiber delivering 193 nm radiation. It would have been obvious to the artisan of ordinary skill to employ a device and method as taught by Abela et al ('982) in the device and method of Matsuura et al (1998) since Matsuura et al (1998) specifically discloses the desirability of using hollow waveguides in medical applications; or to use the device and method of Matsuura et al (1998) in the device and method of Abela et al ('982), since Abela et al ('982) disclose no particular fibers and since these fibers efficiently transmit high energy radiation while exhibiting favorable bending radii; and in either case to employ the tapered tip of Lewis et al, since this provides beam sizes in the range required by Abela et al ('982); or to employ the tapered tip of Lewis et al on the waveguide of Abela et al ('982), since this provides beam sizes in the range required by Abela et al ('982), or to employ the device and method of Abela et al ('982) in the device and method of Lewis et al, since Lewis et al disclose drilling through cell walls as a preferred use of the device, and in either case to employ the hollow waveguide of Matsuura et al (1998), since this allows for the transmission of greater energies and avoids the formation of color centers, which is a problem, as taught by Lewis et al; or to provide the method and device of Lewis et al in the method and device of Matsuura et al (1998), since the tapered tip of Lewis et al provides greater energies and or to provide the method and hollow waveguide device of Matsuura et al (1998) in the device and method of Lewis et al, since this would avoid the production of color centers and enable larger energies to be delivered, and in either case to employ the method and device of Abela et al since this is a medical method as suggested by Matsuura et al (1998), which would benefit from the delivery of high energy radiation and since this device and method is useful for drilling into cell walls, as taught by Lewis et al; and in any case, to apply laser energy density in the range claimed, since can be used

Art Unit: 3735

to produce holes in cell walls, as taught by Kubota et al; to employ a chip as claimed, since this condenses the light and is commercially available, as taught at paragraph [0051] of the instant disclosure; to use any of the claimed inert gasses, since these are all well known inert gasses in the art, are not critical and provide no unexpected result, thus producing a method such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5-10, 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,132,289. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in In re Goodman cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or

narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Applicant's arguments filed November 26, 2007 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number: 10/041,633 Page 6

Art Unit: 3735

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/ Primary Examiner, Art Unit 3735